

REMARKS/ARGUMENTS

Claims 2, 3, 6, 8, 9, 13, and 14 are pending. The Examiner has rejected all of the pending claims. Applicant respectfully traverses the rejection for the reasons set forth below.

I. Response to Rejection Under 35 U.S.C. § 103

Claims 2, 3, 6, 8, 9, 13, and 14 are rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,769,625 to Sher ("Sher") in view of U.S. Patent No. 5,655,902 to Doucet ("Doucet").

Applicant respectfully traverses the Examiner's rejection because the Examiner has not established a *prima facie* ground for rejection.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142. The analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

In evaluating the prior art, references must be read as a whole. There can be no finding of obviousness where a reference teaches away from the proposed modification or combination, or where the proposed modification or combination would destroy the functionality of the reference for its own purpose. *See Gillette v. S.C. Johnson*, 919 F.2d 720, 724 (Fed. Cir. 1990);

In re Geisler 116 F.3d 1465, 1469 (Fed. Cir. 1997); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

Since inventions often tend to be notoriously easily understood in hindsight, the law has repeatedly warned against the dangers of hindsight analysis. One protection against hindsight analyses is that the law requires that references be read as a whole: it is impermissible within the framework of § 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Wesslau*, 353 F.2d 238; 147 U.S.P.Q. 391 (CCPA 1965).

Such picking and choosing appears to be what the Examiner has done in evaluating the cited references. In rejecting the claims, the Examiner has stated:

8. Sher, as discussed above, discloses the invention as claimed with the exception of showing the discs having a diameter larger than the striker wheel (Figure 5).

9. Doucet discloses a similar lighter, having a striker wheel (20) surrounded by two discs (18) in the same manner as Sher and applicant. Doucet teaches placing a sleeve (60) as part of the striker wheel to prevent children from activating the lighter. As seen in Figure 4, the sleeve surrounding the striker wheel has the same diameter as the outer discs.

10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Sher striker wheel to include the sleeve of Doucet, in order to prevent children from operating the lighter (col. 1, lines 11-13).

Contrary to the Examiner's statement, however, upon reading the references as a whole, it would **not** have been obvious to one of ordinary skill in the art to combine the teachings of Sher and Doucet to provide the Applicant's claimed invention. The structure and operation of the lighter in Sher are entirely different from those of the lighter in Doucet. See the Declaration of Kil Yong Sung ("Sung Decl."), ¶¶ 3 and 4. Sher utilizes a child safety mechanism that is wholly different from the child safety mechanism utilized in Doucet. See *id.*

A person of ordinary skill in the art such as Kil Yong Sung would have understood that the lighter in Sher requires a striker wheel having an annular recessed center portion and annular unrecessed lateral portions, where the surfaces of annular unrecessed lateral portions of the striker wheel are smooth so that only an adult's finger (but not a child's finger) can operate the striker wheel for ignition. *See* Sung Decl., ¶ 3; *see also*, col. 1 line 64 – col. 2 line 39 of Sher. As noted by a person of ordinary skill in the art, Sher distinguishes its lighter from prior art on the ground that the surfaces of annular unrecessed lateral portions of the striker wheel in Sher are smooth whereas the striker wheel in prior art has protuberances on the surfaces of annular unrecessed lateral portions. *See* Sung Decl., ¶ 3; *see also*, col. 4 lines 35-45 of Sher. Further, Sher teaches that the striker wheel is mounted to the lighter in slots such that the striker wheel is pressed from a first position having insufficient spring force to ignite into a second position having sufficient spring force to cause the lighter flint to spark when the striker wheel is rotated. *See* Sung Decl., ¶ 3; *see also*, Abstract of Sher. In other words, in order to ignite the lighter of Sher, a user must vertically move down the striker wheel as well as rotate the striker wheel. *See* Sung Decl., ¶ 3.

A person of ordinary skill in the art has acknowledged that the safety mechanism of Sher is significantly different from the safety mechanism of Doucet. *See* Sung Decl., ¶ 4. The safety mechanism in Doucet requires a slip ring (referred as “sleeve” by the Examiner), which is concentrically mounted about a striking wheel assembly, to resist undesired use of the lighter by young children. *See id.*; *see also*, Abstract and col. 1 lines 4-8 of Doucet. The slip ring in Doucet rotates freely about the striking wheel assembly and has an elongated channel so that the ends of the slot engage a flint housing to limit the range of motion of the slip ring. *See* Sung Decl., ¶ 4; *see also*, Abstract and col. 2 lines 33-35 of Doucet. In contrast to the teaching of

Sher, Doucet teaches that the exterior surface of the slip ring is preferably serrated to provide a rough edge for engagement by the user's finger. *See* Sung Decl., ¶ 4; *see also*, col. 3 lines 34-36 of Doucet. To operate the lighter in Doucet, at least a threshold amount of pressure exerted by a finger should be applied to the slip ring which surrounds the striking wheel assembly before the striking wheel assembly can be rotated against flint to create a spark. *See* Sung Decl., ¶ 4; *see also*, col. 1 line 67 – col. 2 line 5 of Doucet. The slip ring in Doucet rotates in either a forward or backward direction in a limited range and, in order to reactivate the striking wheel, the slip ring must be rotated in the backward direction. *See* Sung Decl., ¶ 4; *see also*, col. 6 lines 5-29 of Doucet. A person of ordinary skill in the art would have understood that a user's finger engages only the slip ring and a portion of the striking wheel in operating the lighter in Doucet. *See* Sung Decl., ¶ 4.

Although the structure and operation of the lighter in Sher are entirely different from those of the lighter in Doucet, the Examiner has failed to provide any articulated reasoning and rational underpinning to support his conclusion of obviousness as to how and why a person of ordinary skill in the art would have combined such entirely different structures. As indicated by a person of ordinary skill in the art, it is generally known in the field of lighter technology that a viable and operable safety mechanism in a lighter should prevent a child from operating the lighter but should allow an adult to easily operate it. *See* Sung Decl., ¶ 6. Also, it is generally accepted in the art that the structure of the safety mechanism should be simple to maintain the size of a cigarette lighter to be small. *See id.* Contrary to the Examiner's conclusion, in light of the different structures and operations of the two different safety mechanisms of Sher and Doucet, a person of ordinary skill in the art, at the time the invention of this application was made, would not have had any motive to modify the safety mechanism of Sher to include the slip

ring of Doucet. *See id.* A person of ordinary skill in the art would have thought that such modification would be unsuccessful because it would destroy the functionality of the lighter of Sher for its own purpose. *See id.* For example, a person of ordinary skill in the art would have thought that if such a slip ring as in Doucet were to be installed in the lighter of Sher, it would obstruct operation of the lighter of Sher and would add improper and unnecessary difficulty in rotating the sparker wheel of Sher because the range of motion of the slip ring (which is supposed to rotate freely about the sparker wheel of Sher) would not be properly limited in the lighter of Sher while the sparker wheel of Sher is vertically moving from one position to another. *See id.* Moreover, the closed surface portion of the slip ring (where an elongated slot is not formed) could be located between the sparker wheel and a flint of Sher such that the closed surface of the slip ring itself, rather than the sparker wheel, could frictionally engage the flint to ignite, resulting in a lighter being easily operable by a child. *See id.*

Even if it be assumed that Sher and Doucet would have been combined, Applicant's claim limitations would still be missing from the resulting combination. Specifically, contrary to the Examiner's statement, the slip ring (sleeve) surrounding the striker wheel in Doucet does not have the same diameter as the outer discs (18). As clearly shown in Fig. 3 and described in col. 5 lines 33-40 of Doucet, a space 41 should be provided between the slip ring and the outer discs in Doucet in order to allow the slip ring to freely rotate about the outer discs, and, accordingly, the slip ring of Doucet cannot have the same diameter as the outer discs. *See also*, Sung Decl., ¶ 5. In addition, the surface of the slip ring of Doucet, on which a user's finger or thumb contacts, is rough whereas the surfaces of the circular discs of Applicant's claimed invention are glossy.

For at least the above reasons, the Examiner has not established a *prima facie* case of obviousness with respect to Applicant's pending claims over Sher in view of Doucet, and it

would **not** have been obvious to one of ordinary skill in the art to combine the teachings of Sher and Doucet to provide the Applicant's claimed invention. Accordingly, Applicant respectfully requests the Examiner to withdraw the obviousness rejection.

CONCLUSION

The Examiner is respectfully requested to reconsider his position in view of the remarks and arguments made herein and the supporting declaration submitted herewith. It is believed that all of the pending claims 2, 3, 6, 8, 9, 13, and 14 have been placed in condition for allowance, and such action is respectfully requested.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at (310) 777-8399.

Respectfully submitted,

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